

## **REMARKS**

Applicant has received and carefully reviewed the Final Office Action of the Examiner mailed March 17, 2008. Currently, claims 5-22 and 24-34 remain pending and stand rejected. Favorable consideration of the following remarks is respectfully requested.

### **Claim Rejections under 35 U.S.C. §102**

Claims 5, 11-14, 20-22, 24-26 and 27-34 have been rejected under 35 U.S.C. §102(e) as being anticipated by Foreman et al. (US Patent No. 6,569,192). Applicant respectfully traverses the rejection.

In particular, independent claim 5 recites in part, “a raised pattern of generally noncontiguous elements disposed on the outer surface of the elongate shaft,” “wherein the bearing points are separated when the shaft is not being torqued and wherein at least two of the bearing points move toward one another when the shaft is torque,” and “wherein the raised pattern improves the transmission of torque along the elongate shaft.” Independent claims 12, 25 and 32 recite similar limitations, specifically, a raised pattern on the outer surface of the elongate shaft, at least two protrusions moving toward each other when the shaft is being torque, and the ability to transmit torque along the elongate shaft. Foreman et al. do not disclose these features. MPEP 2131 states that, in order to anticipate a claim, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)."

In formulating the rejection, the Examiner asserts, “Note that the catheter of Foreman in figures 1-2, 4 is capable of improving the transmission of torque along the elongate shaft when torqued, and where adjacent raised shapes are separated fig. 2 when the shaft is not being torque.” Foreman et al. do not describe or suggest a catheter that is configured to improve torque transmission, despite the Examiner’s assertions to the contrary, as the reference does not disclose or describe the structural elements that provide the claimed improvement in torque transmission. In accordance with M.P.E.P. §2112(IV) the Examiner must provide rationale or evidence tending to show inherency. The section states, “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” One of skill in the art would not expect or believe that stent holding protrusions

disposed on an expandable member would impact torque transmission. Certainly, protrusions disposed on a balloon would not be expected or believed to improve torque transmission along an elongate shaft.

Foreman et al. teach at column 2, lines 59-64, “By positioning the protrusions and the stent so that the protrusions extend into the gaps of the stent when crimped onto the expandable member, the protrusions prevent relative motion between the stent and expandable member until the expandable member is inflated to implant the stent,” and at column 4, lines 57-62, “protrusions 16 preferably substantially match shape 26 of gaps 20 in expandable stent 18. Also, height 38 of protrusions 16 is substantially equal to thickness 36 of the expandable stent 18, so that the surface of the assembly is relatively smooth in the location of the stent and protrusions.” Emphasis added. The Examiner does not take into consideration the protrusions are for securing a stent onto an inflatable member and that the stent will be present when the catheter is removed. MPEP 2141.02 VI states, “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).” The device of Foreman et al. teaches away from protrusions present on a surface while the catheter is being placed within the vasculature. Further, Foreman et al. teach that the protrusions prevent relative motion between the stent and the expandable member. The stent is placed over the protrusions such that the stent cannot move relative to the expandable member. Hence, the protrusions do not move toward each other. Furthermore, one of ordinary skill in the art would not equate the expandable member of Foreman et al. with the elongate shaft of the present invention.

For at least these reasons, Applicant respectfully submits that claims 5, 12, 25 and 32 are patentable over Foreman et al. Claims 11, 13-14, 20-22, 24, 27-31 and 33-34 are also believed to be in condition for allowance at least because they depend from one of claims 5, 12, 25 and 32, which are believed allowable, and contain additional limitations to further distinguish them from the prior art. Reconsideration and withdrawal of the rejection is respectfully requested.

#### **Claim Rejections under 35 U.S.C. §103**

Claims 6-10 and 15-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Foreman et al. (US Patent No. 6,569,192). Applicants respectfully traverse the rejection.

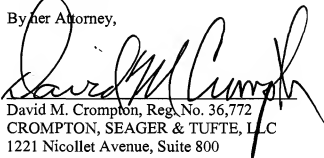
Claim 5, from which claims 6-10 depend, and claim 12, from which claims 15-19 depend, have been distinguished above as being patentable over Foreman et al. As claims 6-10 and 15-19 include the elements of claims 5 and 12, respectively, as well as additional features and elements, they are also patentable over Foreman et al. Reconsideration and withdrawal of the rejection is respectfully requested.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,  
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By her Attorney,

Date: \_\_\_\_\_

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